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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/771,692

01/30/2001

Madoka Mitsuoka

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8152

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7590

06/27/2005

STAAS & HALSEY LLP

SUITE 700

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WASHINGTON, DC 20005

EXAMINER

MYHRE, JAMES W

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/771,692

Applicant(s)

MITSUOKA ET AL.

Examiner

James W. Myhre

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 February 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Amendment*

1. The response filed on February 23, 2005 is sufficient to overcome the Horstmann (6,285,985) reference. The response did not amend, add, or delete any claims. Therefore, the currently pending claims considered below remain Claims 1-17.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Govindarajan et al (6,208,659).

Claims 1, 3, and 12-17: Govindarajan discloses a method, program, and apparatus for using status symbols (icons), comprising:

- a. storing a user status-setting symbol (icon) (Figure 6A, item 610 and col 11, lines 20-25);
- b. selecting by a first user a status icon to use as a self-status designation (Figure 6A, item 610 and col 11, lines 20-25);

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c. distributing over the network to a second user the status icon representing the first user's status (Figure 6B, item 620; col 11, lines 48-61; and col 12, lines 34-37); and selecting the status icon by the second user to use as a self-status designation (col 11, lines 20-25).

While Govindarajan discloses that the status icon may represent a business, such as one employing the user, it is not explicitly disclosed that the status symbol (status icon) represents an advertiser. However, these claims do not include any functionality pertaining to the ownership of the symbol; thus, little, if any, patentable weight is given to what or whom the icon represents. It would have been obvious to one having ordinary skill in the art at the time the invention was made that the status symbol selected by the first user could represent any type of entity or non-entity to include an advertiser. For example, the symbol to represent that the first user is traveling could be a generic drawing of a car or it could be a picture of a Ford Mustang (representing the Ford Motor Company, i.e. an advertiser). Either type of symbol could be used to denote the status of the first user in Govindarajan without altering the above claimed steps.

While Govindarajan does not explicitly disclose that the second user also requests to use (selects) the status symbol to represent his status, it would have been obvious that any user connected to the system could select one of the store symbols as a self-status designation symbol. If the second user liked the symbol displayed as a status symbol of the first user, he would have been motivated to select the status-symbol to also represent his status.

Claim 2: Govindarajan discloses a method for using status symbols (icons) as in Claim 1 above, and further discloses the first user requesting the use of the symbol through a web page (col 4, lines 54-57). While it is not explicitly disclosed that the webpage is provided by an advertiser, the owner of the webpage in the claim is only accepting the request from the first user to use the symbol and is not providing any advertising to the first user. Thus, little if any patentable weight is given to the ownership of the webpage at which the symbols are stored. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that any entity, including an advertiser, could be providing the webpage with the stored symbols from which the first user selects his desired status symbol. One would have been motivated to have an advertiser provide the webpage in order to have financial backing for the whole system (through the advertiser's advertising budget).

Claim 4: Govindarajan discloses a method for using status symbols (icons) as in Claim 1 above, but does not explicitly disclose charging any of the entities for using the symbol. Official Notice is taken that it is old and well known within the economic arts to place a value on an icon representing a business or other entity and to either charge or pay another entity for displaying (using) the icon. For example, franchisees usually pay the franchiser for the privilege of displaying the franchiser's symbol on the franchisee's place of business, business cards, advertisements, etc. Likewise, businesses pay other entities to display their symbol/logo/icon, such as a sporting goods company paying a professional athlete to wearing clothing prominently displaying the company's logo or

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name. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention for the entities in Govindarajan to either pay or receive payment for using the symbol. One would have been motivated to include such payments in Govindarajan in order to make the system financially viable.

Claim 5: Govindarajan discloses a method for using status symbols (icons) as in Claim 1 above, but does not explicitly disclose the owner of the icon providing privileges when the first user selects the symbol as his status-symbol. However, this claim is broad enough that the claimed "privileges" would encompass the first user receiving payment for using the symbol as discussed in the rejection of Claim 4 above.

Therefore, it would have been obvious to inform the first user of such privileges upon the selection of the symbol by the first user. One would have been motivated to inform the user of such privileges in order to possibly influence his choice of symbols from the stored symbols database (e.g. the user would be more likely to choose a symbol which pays him over a symbol which charging him for its use).

Claim 6: Govindarajan discloses a method for using status symbols (icons) as in Claim 1 above, and further discloses the system (awareness device) setting the status symbol based on changes to the first user's status (col 14, lines 56-63 and col 16, lines 34-41).

Claims 7 and 8: Govindarajan discloses a method for using status symbols (icons) as in Claim 1 above, but does not explicitly disclose that the advertiser is charged a fee based on the number of referrals (click-throughs) for the symbol selected by the first user nor that the first user receives an incentive (such as a coupon) also based on the number of referrals. However, Official Notice is taken that it is old and well known within the advertising arts to charge an advertiser based on the number of exposures their advertisement has received, such as the number of click-throughs a banner advertisement receives on a webpage. It is also well known to provide incentives which vary using the same criteria to the owner of that same webpage. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to bill the advertiser and to provide incentives to the first user based on the number of "referrals" counted during a time period. One would have been motivated to based the bill and incentive on the number of referrals in order to maintain the equitability and fairness of the system to both the advertiser and the user.

Claims 9-11: Govindarajan discloses a method for using status symbols (icons) as in Claim 1 above, and further discloses the system (awareness device) setting the status symbol based on changes to the first user's status (col 14, lines 56-63 and col 16, lines 34-41). While it is not explicitly disclosed that the user's status is changed when the user visits or makes a purchase at a retail outlet or when content is accessed online, these would all be encompassed the disclosure that the system changes the status symbol of the user when the user's status changes. The Govindarajan system

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does not react differently based on where the user's status information is coming from. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to change the status symbol in Govindarajan when the user visits or makes a purchase at a retail outlet or accessed content online. One would have been motivated to apply these changes to the status symbol in order to keep the current status of the user up-to-date.

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Nielsen (5,813,007) discloses a method, program, and apparatus for using status icons within a bookmarking system to indicate the status of previously accessed webpages.

b. Nagarajayya et al (5,940,078) discloses a method, program, and apparatus for changing the appearance of icons being displayed.

c. Gong (6,243,089) discloses a method, program, and apparatus for altering the display of status icons based on detected status changes.



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d. Isreal et al (6,330,007) discloses a method, program, and apparatus for a graphical user interface which incorporates status icons.

e. Baker (6,546,417) discloses a method, program, and apparatus for displaying status icon next to email messages.

f. Kolls (6,601,038) discloses a method, program, and apparatus for receiving additional information when clicking on an advertiser's icon.

g. Gould et al (6,693,236) discloses a method, program, and apparatus for displaying status icons on a graphical user interface monitoring inventories.

h. Brisebois et al (6,738,809) discloses a method, program, and apparatus for graphically displaying the status of a plurality of entities/users.

i. Pennock et al (6,807,562) discloses a method, program, and apparatus for displaying icons selected by a first user to represent his status to a second user.

j. Mitsuoka et al (US 2002/0026355A) is the publication of the present application.

k. Tsou et al (US 2002/0184089A) discloses a method, program, and apparatus for performing the presently claimed invention. However, this reference was filed over 4 months after the present application.

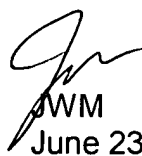
l. IBM Technical Disclosure Bulletin, "New Icons", discloses a plurality of novel icons which may flash, change color, make sounds, etc. for use within webpages, buddy lists, IM systems, etc.

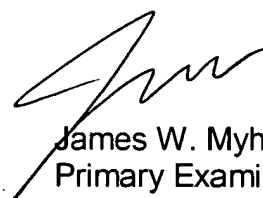
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (571) 272-6722. The examiner can normally be reached Monday through Thursday from 5:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (571) 272-6724. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (571) 273-6722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-3600.

  
JWM  
June 23, 2005

  
James W. Myhre  
Primary Examiner  
Art Unit 3622